



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,952	08/03/2001	Hiroshi Satomi	B422-167	8387

26272 7590 07/27/2005

COWAN LIEBOWITZ & LATMAN P.C.
JOHN J TORRENTE
1133 AVE OF THE AMERICAS
1133 AVE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,952

Applicant(s)

SATOMI ET AL.

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-79 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 61-79 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on March 17, 2005. **Claims 61-79** are now pending in the present application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 61-65, 67-74, 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. US Patent Pub. 2001/0039560 in view of Mousseau et al. US Patent Pub. 2001/0005864.

Regarding claim 61, 70, 78 and 79, Uchida teaches an information providing system, method, program product and storage medium holding a control program for a computer to execute a method of operating an information providing system (abstract) comprising:

receiving means adapted to receive electronic mail information, (paragraphs 0070 and 0074);

Art Unit: 2645

registering means adapted to register the electronic mail information in correspondence with code information, (paragraphs 0074 and 0077);

notifying means adapted to notify the code information corresponding to received electronic mail information to the destination device, (paragraph 0082),

inputting means adapted to input the notified code information to an output device; acquiring means adapted to acquire the electronic mail information based on the input code information, (paragraph 0082).

Uchida does not specifically teach of determining means adapted to determine whether or not a destination device of said electronic mail can display the information.

In the same field of endeavor, Mousseau teaches determining means adapted to determine whether or not a destination device of said electronic mail information can display the electronic mail information, (paragraphs 0016, 0034, 0035, 0042, 0072 and 0073).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select an alternative device to view the received information if the user's first device cannot view the received information.

Regarding claim 62, Uchida in view of Mousseau, as applied to claim 61, teaches wherein said output device is a printing apparatus, (paragraph 0035).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select

Art Unit: 2645

an alternative device to view the received information if the users first device cannot view the received information.

Regarding claims 63 and 71, Uchida, as applied to claims 61 and 70, teaches wherein said outputting means also outputs the inputted code information, (paragraph 0082).

Regarding claims 64 and 72, Uchida, as applied to claims 61 and 70, teaches authenticating means adapted to authenticate a user of the destination device, wherein said registering means is operable to register the electronic mail information and the code information in accordance with an authentication result, (paragraphs 0074 and 0077).

Regarding claims 65 and 73, Uchida, as applied to claims 61 and 70, teaches wherein the electronic mail information includes a file attached to an electronic mail, (paragraph 0071).

Regarding claims 68 and 76, Uchida in view of Mousseau, as applied to claims 61 and 70, teaches second determining means adapted to determine whether or not an output device can output the received electronic mail information, (paragraphs 0016,0034,0035,0042,0072,0073).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select an alternative device to view the received information if the users first device cannot view the received information.

Regarding claims 69 and 77, Uchida in view of Mousseau, as applied to claims 61 and 70, teaches wherein said notifying means is further operable to notify that an output device can output the electronic mail information, (paragraphs 0073,0076,0078).

Art Unit: 2645

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Uchida by determining whether or not a destination device of said electronic mail can display the information as taught by Mousseau so that the user can select an alternative device to view the received information if the users first device cannot view the received information.

Regarding claim 74, Uchida, as applied to claim 73, teaches wherein the attached field is an image data or an application data, (paragraph 0071).

5. Claims 66 and 75 rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Mousseau and further in view of Watanabe US Patent Pub. 2001/0034226.

Regarding claims 66 and 75, Uchida in view of Mousseau, as applied to claims 67 and 70, do not specifically teach wherein the electronic mail information includes characters exceeding the number of characters receivable for the destination device.

In the same field of endeavor, Watanabe teaches of determining that the e-mail cannot be outputted in a destination if the maximum number of character is exceeded, (paragraphs 0050 and 0052).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mousseau by determining that the e-mail cannot be outputted if the maximum number of characters is exceed so that the user can be notified that there destination device cannot view the entire message.

Response to Arguments

6. Applicant's arguments with respect to claims 61-79 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 09/921,952

Page 7

Art Unit: 2645

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER



Ovidio Escalante
Examiner
Group 2645
July 22, 2005

O.E./oe